

REMARKS/ARGUMENTS

Applicant thanks the Examiner for his detailed comments in the Office Action. The Office Action has been carefully considered. It is respectfully submitted that the issues raised are traversed, being hereinafter addressed with reference to the relevant headings appearing in the Detailed Action section of the Office Action.

Final Office Action

The Examiner has stated at item 11 on page 6 that:

"The Examiner acknowledges that claims 30 and 33 were not previously explicitly recited in the previous rejection. Therefore, this rejection is not made final."
(emphasis added)

The Applicant notes that the Office Action Summary indicates that the Office Action is made Final, as the check box has been checked.

The Applicant requests clarification of the status of the Office Action (ie is the Office Action non-final or final) due to the inconsistencies in the Office Action between the Examiner's comments and the Office Action Summary.

The Applicant has proceeded to assume that the Office Action Summary is incorrect in light of the Examiner's comments and therefore the Office Action is non-final, however, the Applicant still requests clarification in any following Office Action.

Claim 36

In the previous Office Action mailed September 8 2005, the Examiner stated on page 5 that:

"Claims 14 and 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims."

The Applicant noted on page 10 of the Applicant's response to the Office Action mailed 8 September 2005:

"We have also inserted new independent claims 35 and 36. ... Claim 36 is a combination of subject matter of claims 1 and 25. The Examiner has indicated at

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paragraph 9 of the Office Action that these claims would be allowable if rewritten in independent form."

Claim 36 specifies:

Coded data for disposal on or in an interface surface associated with a product item, wherein the coded data includes a plurality of coded data portions disposed on or in the interface surface, and wherein each coded data portion is indicative of an identity of the product item such that sensing any one of the coded data portions allows the identity of the product item to be determined, and wherein the coded data is redundantly encoded using Reed-Solomon encoding.

Claim 25 has been rewritten in independent form as noted in claim 36. Claim 36 also includes limitations of the intervening claim 24, as claim 24 specified that the coded data is redundantly encoded.

Therefore, we cannot see any valid justification for the Examiner to reject claim 36 as being anticipated by Kawai et al (US Patent No 5,128,527), as indicated page 2 of the Office Action, and also noted on the Office Action Summary.

The Applicant requests a detailed explanation as to how claim 36 can be rejected as being anticipated by Kawai et al in light of the Examiner's comments from the previous Office Action mailed 8 September 2005 and further in light of the Examiner's comments on page 5 of the current Office Action.

In light of the numerous inconsistencies in the Office Action, the Applicant respectfully requests that if there is a next Office Action, that this next Office Action also be made non-Final, such that the Applicant can fully and comprehensibly respond to the inconsistent rejections raised in this Office Action.

Item 2 of Office Action

At paragraph 2 of the Office Action, the Examiner noted that claim 1 has been amended to recite "productivity". The Examiner has interpreted, based on the remarks in the Applicant's response that the claims is intended to recite "product item". The Applicant confirms that this was a typographical error and that this interpretation of claim 1 is correct. Applicant

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thanks the Examiner for correctly interpreting the claim, despite the typographical error, in light of the Applicant's remarks.

Claim 1 has been amended to clarify that the identity is adapted to distinguish the product item from each other product item. Furthermore, the remaining independent claims have been amended to specify "each other product item". Support for this feature can be found from previously cancelled claim 3 as well as section 8 of the specification. The Applicant submits that the amendment introduces no new subject matter.

Claim Rejections – 35 USC § 102

At page 2 of the Office Action, the Examiner has rejected claims 1, 2, 4- 11, 13, 15-21, 30-33, 35 and 36 as being anticipated by Kawai et al (US Patent Number 5,128,527).

For the purposes of the Applicant's response, the Applicant will not comment on the rejection to claim 36 as this has been previously questioned above.

The Examiner has stated on page 5 that:

"Applicant argues that the UPC add on code does not identify the product item. The Examiner agrees. However, this does not define the current invention over the prior art relied upon for rejection. The examiner points out that the main UPC code identifies the product item itself. Further, there is currently no limitation that the product item be the add on code or the main code, i.e. the examiner is free to interpret the product item identifier to be encoded in any portion of a bar code"

With all respect to the Examiner, this reasoning is incorrect. Claim 1 states "each coded data portion is indicative of an identity of the product item". The term each means that all coded data portions are indicative of an identity of the product item. The Examiner has explicitly stated his interpretation of coded data portion on page 2 to include "a UPC left block, UPC right block and add-on code".

As the Examiner has admitted that "*the UPC add on code does not identify the product item*", based on the Examiner's interpretation of coded data portion, each coded data portion is not indicative of the product item.

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The Applicant respectfully submits that the Examiner is not free to interpret the product item identifier to be encoded in any portion of a bar code as this is contradictory to the previous interpretation which the Examiner has applied on page 3 of the Office Action as to what a coded data portion is, and further strains the interpretation of

The Applicant respectfully submits that the Examiner cannot strain the interpretation of the word "each" to fit the meaning of "some". This is not a fair construction of the terms in the claims and further strains the general English meaning of the word. The Applicant further submits that the Examiner must stay consistent throughout the Office Action with the interpretation of a term in the claim. As the Examiner has interpreted the coded data portions to include the add-on code in Kawai et al , and as the Examiner has admitted that the add on code does not identify the product item, there is no valid broad interpretation that the Examiner could successfully apply to reject the claim as being anticipated by Kawai et al.

We also note that the Examiner has stated at paragraph 4 that *"The add-on code is in the same code format as the traditional UPC code and thus is also interpreted as containing UPC coded information"*. This interpretation is in total contrast to the last line first paragraph in column 1 of Kawai et al which states:

"...the add-on code being different from the UPC in the bar code system."

This interpretation applied by the Examiner has no support from the disclosure of Kawai et al. In fact, the interpretation applied by the Examiner is actually contradictory to what Kawai et al discloses throughout the entire specification. The Applicant respectfully requests the Examiner to reconsider this interpretation of "add-on code" based on what is actually taught in the Kawai et al citation

The MPEP states at 2131 that:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."
Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). >

Kawai et al fails to disclose the element of *"each coded data portion is indicative of an identity of the product item"*. As each and every element as set forth in the claim has not be

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found, either expressly or inherently described, in a single prior art reference, the Applicant respectfully submits that the claim is not anticipated by Kawai et al.

In regard to independent claim 35 which was introduced in the response to the previous Office Action, although claim 35 was not written to include all intervening claims, the Examiner has failed to explicitly state that Kawai et al discloses "*the layouts are arranged to tessellate over the interface surface*". Therefore, the Applicant respectfully submits that claim 35 is not anticipated by Kawai et al, as the element of discloses "*the layouts are arranged to tessellate over the interface surface*" claim has not be found, either expressly or inherently described, in Kawai et al.

The above arguments also apply to the remaining independent claims.

Reconsideration and withdrawal of the claim rejection is respectfully requested.

Claim Rejections – 35 USC § 103

At paragraph 7 of the Office Action, the Examiner has rejected claims 12, 22-24 and 26-29 as being unpatentable over Kawai et al.

At paragraph 7 of the Office Action the Examiner has stated "*Kawai does not disclose the interleaved code. Official Notice is taken that interleaved codes are old and well known*".

Although, as stated by the Examiner, interleaved codes can provide robustness, the Applicant submits it is not old and well "*the positions of the data elements of respective sub-layouts being interleaved*" as required in claim 12. The Examiner has stated on page 3 of the Office Action as "*the left block, right block and add-on of the UPC are interpreted as being sub-layouts*". The Applicant notes that the sub-layouts of the left block, the right block and the add-on block are spatially separated and therefore can be in no way interpreted as interleaved. Interleaving data elements between respective sub-layouts (under the Examiner's interpretation) would render a bar code, such as that disclosed in Kawai et al, uninterpretable. Therefore, in accordance with MPEP 2144.03, the Applicant respectfully challenges the Examiner to prove that "*interleaved codes are old and well known*".

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The MPEP states at §2143 "*Basic Requirements of a Prima Facie Case of Obviousness*" that:

"... three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

As the Examiner has relied upon of Kawai et al. for disclosing of "*each coded data portion is indicative of an identity of the product item*", which we have noted above is not expressly or inherently described in this reference, the third basic requirement of a prima facie case of obviousness has not been satisfied in respect of Kawai et al. In particular, Kawai et al fails to teach or suggest all the claim limitations including "*each coded data portion is indicative of an identity of the product item*". As all three basic requirements of a prima facie case of obviousness must be met in order to state that a claim is obvious and therefore reject the claim as unpatentable, the Applicant respectfully requests that this claim rejection be withdrawn as all three basic requirement has not been satisfied.

The above arguments also apply to the remaining independent claims.

Reconsideration and withdrawal of this claim rejection is respectfully requested.

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CONCLUSION

In view of the foregoing, it is respectfully requested that the Examiner reconsider and withdraw the rejections under 35 U.S.C. §102(b) and 35 U.S.C. §103(a). The present application is believed to be in condition for allowance. Accordingly, the Applicant respectfully requests a Notice of Allowance of all the claims presently under examination.

Very respectfully,

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